

Docket No. 200209168-1

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Remarks

This communication is responsive to the Restriction Requirement of October 2, 2006. Applicant makes elections as set forth below. Reexamination and reconsideration of claims 1-36 and 38-54 is respectfully requested.

Summary of The Restriction

Restriction to one of the following species was required under 35 U.S.C. 121, as described in the Office Action:

Species I: discloses a first fire line, a second fire line, a first address generator, a second address generator, a first set of drop generators, and a second set of drop generators;

Species II: discloses a first fire line, a second fire line, means for generating first address signals, means for generating second address signals, means for responding to the first energy signal to eject fluid based on the first address signals, and means for responding to the second energy signal to eject fluid based on the second address signal;

Species III: discloses generating first address signals, generating second address signals, receiving a first energy signal, receiving a second energy signal, responding to the first energy signal, and responding to the second energy signal;

Species IV: discloses a first fire line, a first source of address signals, first resistors, and a second source of address signals;

Species V: discloses a first source of address signals, a second source of address signals, first address lines, second address lines, first resistors, and second resistors, wherein the first address generator and first resistors are located on a first portion of the fluid ejection device and the second address

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generator and second resistors are located on a second portion of the fluid ejection device;

Species VI: discloses a method comprising a first group of resistors, a second group of resistors, first address signals, second address signals, providing first address signals to the first resistors, and providing second address signals to the second resistors;

Species VII: discloses a first fire line, data lines, a first fluid feed source, first drop generators, second drop generators, a first address generator, and a second address generator;

Species VIII: discloses means for receiving a first energy signal, means for receiving data signals, means for supplying fluid, means for receiving fluid, means for providing first address signals, means for responding to the first address signals, means for providing second address signals, and means for responding to the second address signals;

Species IX: discloses a method comprising receiving a first energy signal, receiving data signals, providing first address signals, supplying fluid from a first feed source, ejecting fluid from the first drop generators, providing second address signals, and ejecting fluid from the second drop generators;

Species X: discloses a first fire line, a second fire line, an address generator, a latch, a first drop generator, and a second drop generator;

Species XI: discloses a first fire line, an address generator, a latch, and first drop generators;

Species XII: discloses means for receiving a first energy signal, means for receiving a second energy signal, means for generating address signals, means for latching the address signals, means for responding to the first energy signal, and means for responding to the second energy signal;

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Species XIII: discloses a method comprising providing an address generator, a latch, a first energy signal, a second energy signal, responding to the first energy signal based on the address signals, responding to the second energy signal based on the latched address signals.

Election

Applicant elects, with traverse, Species I. A listing of claims readable on Species I are claims 1-36 and 38.

Applicant traverses the restriction as follows.

MPEP 809.02(a) "Election of Species Required" cites MPEP § 808.01(a) for determining when a restriction between species is appropriate. MPEP 808.01 states:

MPEP 808.01 Reasons for Holding of Independence or Distinctness

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to a combination and a subcombination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the subcombination as claimed. (MPEP 808.01)

The Office Action articulates that the reason for requiring an election of a single species as:

"The species are independent or distinct because each species requires a different and extensive search." (Office Action, page 4, paragraph 3)

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Applicant respectfully submits that the reason of “a different and extensive search” does not appear as a valid reason under MPEP 808.01 and does not prove that the identified species are independent and distinct. For proving distinct claims in a restriction, MPEP 806.05(e) states, “The burden is on the examiner to provide reasonable examples that recite material differences.” Since no reasonable examples have been provided, a prima facie case for the propriety of the restriction requirement has not been presented. Thus, the restriction should be withdrawn.

As an additional reason for traversal, a comparison of the limitations and scope of each independent claim shows that the claims share many of the same limitations. Thus, the independent claims overlap in scope and therefore, the species are not mutually exclusive. Accordingly, restriction between claims limited to species should not be required based on MPEP 806.04(f), which states:

MPEP 806.04(f) Restriction Between Mutually Exclusive Species

Where two or more species are claimed, a requirement for restriction to a single species may be proper if the species are mutually exclusive. Claims to different species are mutually exclusive if one claim recites limitations disclosed for a first species but not a second, while a second claim recites limitations disclosed only for the second species and not the first. This may also be expressed by saying that to require restriction between claims limited to species, the claims must not overlap in scope. [Emphasis Added]

In view of MPEP 806.04(f), the identified species are not mutually exclusive and the restriction should be withdrawn.

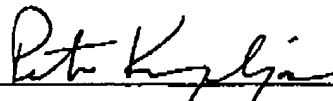
Applicant respectfully notes that the first Office Action dated 4-20-2006 reflects that a full and extensive prior art search for all pending claims was performed. Furthermore, a substantive examination on the merits was provided. In Applicant's response, no new claims were added. Therefore, if a “different and extensive search” was not needed then, how can this be a reason for restriction at this time for the same claims. Indeed, with today's

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technology of easily searchable databases, broad and extensive searches can be performed in short periods of time. Thus, the restriction is not justified and should be withdrawn.

Applicant further notes that each of the 13 species identified in the restriction appear to correspond to one of the 13 independent claims. Although the present application includes extra independent claims, Applicant has paid additional fees for the extra claims as required by the Patent Office. The purpose of the additional fees are to pay for the extra time needed for searching and examining the application. Therefore, Applicant respectfully requests that the restriction be withdrawn and that all pending claims be reexamined in view of Applicant's previously filed response dated July 19, 2006.

Respectfully submitted,



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